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EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,086

Applicant(s)

SHOJI ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1- 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the original application.
Claims 1- 27 are pending in the present application.
Claims 1, 9, 15, 23, 24, 25, 26 are independent.

Priority:

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 08/25/2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC §101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1, 23-26 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.**

The present basis for a 35 USC 101 inquiry is a two-prong test :

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As to the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

As to claim 1, in the present case, the claimed invention produces an exchange of points (i.e., repeatable, useful and tangible).

However claim 1 fails the first prong of the test.

Under this test, for a process claim to pass muster under the “technological arts” prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 has only trivial connection to the technological arts. In claim 1, only the step of accessing a first server is a technological step and it involves a trivial use of technology. All the “allowing” steps do not mean the consumer actually does these steps using the server. Further, the “converting” step can be done manually with pen and paper. Thus the invention is not considered to be within the technological arts.

To overcome this rejection the Examiner would suggest Applicants to amend the claim to incorporate elements of the computer network system and tie at least one significant step to the network system elements.

Claim 23 is rejected because the “information recording medium” may be paper. The “program information for prompting” is not necessarily computer executable code nor on a computer readable medium, it could be just a set of instructions printed on the card. Further the URL information is not necessarily an active link, tied to any computer, i.e. it can be just text printed on the card. Thus claim 23 is not necessarily an IC card.

Claims 24, 25, 26 are rejected on the same basis as claim 23.

Double Patenting

4. Applicants are advised that should claim 16 be found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1,3-5, 9-12, 15-16, 19-22, 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 reads:

A method for at least one consumer to exchange points Sakakibara

issued by various sources comprising the steps of:

- a) accessing a first server,
- b) displaying an exchange rate of points between said consumer's points and at least one other form of points,
- c) allowing said consumer to select which points they wish to convert said consumer's points into of any points available by use of said first server,
- d) allowing said consumer to inform said first server of said consumer's decision to convert said consumer's points to said points available,
- e) allowing said consumer to input any identifying information that consumer uses said consumer's points,
- f) allowing said consumer to provide information that said consumer wishes to use as identifying information in relation to said points available,
- g) converting said points of said consumer to points that said available points based on said exchange rate, and
- h) providing said consumer with said available points.

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(Letters have been added to this claim steps for ease of discussion.)

Step c), e), g) are grammatically incomprehensible. Further the “allowing” steps render the claim’s scope and breadth unclear: it is not clear whether these steps are performed or not. Appropriate correction is required.

For art application purposes claim 1 is interpreted as follows:

A method for at least one consumer to exchange points issued by various sources comprising the steps of:

- a) accessing a first server,
- b) displaying an exchange rate of points between said consumer's points and at least one other form of points,
- c) by use of said first server, said consumer selecting which points they wish to convert said consumer's points into of any of the points available
- d) consumer informing said first server of said consumer's decision to convert said consumer's points to said points available,
- e) said consumer inputting any identifying information that consumer uses for said consumer's points,
- f) said consumer providing information that said consumer wishes to use as identifying information in relation to said points available,
- g) converting said points of said consumer to points of that said available points based on said exchange rate, and
- h) providing said consumer with said available points.

As to claims 3-5, 11-12, it is not clear what “points” refer to: the points sought or the ones to be exchanged from. It is interpreted Applicants mean both or either for prior art application.

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As to claim 9, terms such as “can occur” in a point transaction can occur” “capable of use” as to servers 2 and 3, “capable of sending” , a terminal that “can be used” , a user who “can indicate” render the claim’s scope and breadth unclear: it is not clear whether these steps are performed or not. Appropriate correction is required.

“ a communication network” in “at least one terminal computer connected to a communication network” renders the claim confusing: is this the same network as in the preamble?

As to claim 10, ‘as required” in “assign and record said consumer points as required to exchange points” renders the claim indefinite.

As to claims 15-16, 19-22, and 23-25, they are rejected because the scope and breadth of these claims are indeterminable as process steps seem to be mixed in article of manufacture claims .

For example, as to claim 15, “wherein service points are added to a number of points previously allocated to said card itself when said consumer browses said first information when said information recording medium is read and accesses a server corresponding to said URL information” , which involves at least some computer steps, is mixed in a point card claim.

As to claim 16, “ wherein said service points provide different numbers of points in accordance with a plurality of said second information pieces” in an article of manufacture claim renders the claim’s scope and breadth unclear.

Claim Rejections - 35 USC §102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 3-7, 9, 10-12,14, 26,27 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakakibara, US 6721743 B1, herein Sakakibara.

As to claims 1, 2, 9, 10, 26, 27, Sakakibara discloses method, system, computer programs for at least one consumer to exchange points issued by various sources comprising the steps of:

a) accessing a first server (see at least Fig. 7A and B, central unit 10, and associated text),

b) displaying an exchange rate of points between said consumer's points and at least one other form of points (see at least Fig. 4 and associated text),

c) by use of said first server, said consumer selecting which points they wish

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to convert said consumer's points into of any of the points available (see at least Fig. 7B steps S101, 102, and associated text: user chooses available communication points)

d) consumer informing said first server of said consumer's decision to convert said consumer's points to said points available (see at least Figs 7A, communication from user terminal to central unit 10 and associated text),

e) said consumer inputting any identifying information (interpreted as authentication information: (see at least Figs. 7A , items S101 and S102 and associated text) that consumer uses for said consumer's points),

f) said consumer to provide information that said consumer wishes to use as identifying information in relation to said points available (it is interpreted the user gives at least his name which he has in steps S101 and S102 of Fig. 7A),

g) converting said points of said consumer to points of that said available points based on said exchange rate (see at least Figs. 4, 7A, B, and associated text), and

h) providing said consumer with said available points (see at least Figs. 7B, item S112 and associated text).

As to claims 3, 4, 11 (dependent on claims 1 and 9, respectively), Sakakibara discloses the points comprise points from purchases using a credit card or mileage points (see at least Fig. 4 "airline" and associated text).

As to claims 5, 12, (dependent on claims 1 and 9, respectively), Sakakibara discloses the sought points comprise units for payment of pre-paid access to network sites (see at least abstract: "communication points").

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As to claims 6, 7, Sakakibara discloses wherein said accessing step is conducted via a network, the Internet.

As to claims 14. (dependent on claim 9), Sakakibara inherently discloses at least one server and at least one database which can issue points of different classes and different names (see at least Fig. 4 and associated text).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakakibara.

As to claim 2 (dependent on claim 1), Sakakibara discloses converting further comprises:

a) forming a communication link between said first server and a second server which issued said consumer's points (see at least Figs. 7A and B and associated text),

c) communicating to second server said identifying (authentication) information of said points (see at least Figs. 7A and B and associated text),

d) allowing said second server to assign ownership of said consumer points to said first server (see at least Figs. 7B step S108, S109 and associated text),

As to steps b), e), f), g),

b) forming a communication link between said first server and a third server which issued or can issue points which said consumer seeks,

e) communicating from said first server to said third server a request to assign said sought points,

f) communicating from said first server to said third server a request to record said new identifying information in assigning said available points, and

g) receiving from said third server confirmation that said available points have been assigned in the event that assignment is successfully carried out.

Figs. 7A and B show the central server acting also as the issuer of the sought points and filling all the steps as above-claimed. Official Notice is taken that it is well-known to split computing functions onto many servers as the system configuration requires. Thus it would have been obvious to one skilled in the art at the time the invention was made to split the functions performed by Sakakibara's central unit 10 to another server for ease of computing.

As to claims 8, 13 (dependent on claims 1 and 9, respectively), Sakakibara does not specifically disclose providing points with time limitations on their use and erasing information of ownership of said points with time limitations upon expiration of said time limitation. However, Official Notice is taken that it is well-known to provide limited time points which expire automatically (ownership is inherently erased thereby). It would have been obvious to one skilled in the art at the time the invention was made to add such 'available points' to the ones cited by Sakakibara to extend Sakakibara's system to those "available points" participants who so desire consistent with their business plans.

11. Claims 15, 16-18, 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al., US 6,450,407 B1, herein Freeman.

As to claim 15, Freeman discloses

A point card (chip card , see at least abstract) dispatched with points (rebate money) recorded on an information recording medium comprising:

a) first information recorded on said information recording medium (see at least col. 11 line 61-62: ad thumbnail)
; and

b) URL information unique to said first information,
previously recorded together with said first information (see at least col.11 line 57-65).

As to c) “wherein service points are added to a number of points previously allocated to said card itself when said consumer browses said first information when said information recording medium is read and accesses a server corresponding to said URL information.”

all of this step c) is not a limitation of the structure claimed and therefore will not be considered. This is because this claim is directed to the physical structure of the card by itself. All of step c) is not performed by the structure claimed (a point card) but rather by some other structure such as a server (i.e. there is no indication that the card adds points to itself, there is no explicit or implicit recitation of some adding means on the card, and the browsing is the use of the card, not further explicit or implicit structure of the card per se).

As to claim 16(dependent on claim 15) discloses
said first information includes a plurality of different

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types of second information pieces (see at least Fig. 4, item 132 and associated text: ad with different data).

As to “wherein said service points provide different numbers of points in accordance with a plurality of said second information pieces” is not a limitation of the structure claimed and therefore will not be considered. This is because this feature not performed by the structure claimed (a point card) but rather by some other structure such as a server.

As to claims 17 an 18 (dependent on claim 15) advertisement or questionnaire information being said first information on the card is non-functional data. This is because nothing is done with such information. It would have been obvious to one skilled in the art at the time the invention was made to add any kind of data as one pleases onto the card as disclosed by Freeman.

As to claim 20 (dependent on claim 19), “wherein said server corresponding to said URL information is a server in a point exchange system wherein at least one consumer exchanges points issued by a variety of sources” ” is not a limitation of the structure claimed and therefore will not be considered for the same reasons as stated in claim 15.

As to claim 21(dependent on claim 20), Freeman discloses said URL information is complicated information because any URL is complicated information.

As to “which describes directory information at a lower hierarchical level that cannot be accessed by a consumer who is unaware of said URL information” is not a limitation of the structure claimed and therefore will not be considered for the same reasons as stated in claim 15.

As to claim 22 (dependent on claim 20),

“wherein said server comprises means for adding the number of card points of said user as a predetermined number of service points based on said URL information entered from a user terminal.” is not a limitation of the structure claimed and therefore will not be considered for the same reasons as stated in claim 15.

As to claim 23, Freeman discloses a point card with advertisement information recorded thereon URL information unique to said advertisement information (see at least col. 11 lines 57-65).

As to the “program information for prompting said consumer to browse said advertisement information when said information recording medium is read, and for adding service points to a number of points previously allocated to said card itself when said consumer accesses a server corresponding to said URL information”, only the program information is a feature of the card, which may not be computer program as stated earlier, and is non-functional data.

Freeman may not teach the specific program information recited in the claimed invention. However, the specific meaning/interpretation of the program information does not patentably distinguish the claimed system. Further, the recited statement of intended use of the program information does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of program information in the system taught by Freeman because the subjective interpretation of the program information does not patentably distinguish the claimed invention: a point card.

It is noted however that the Freeman chipcard does carry a program to access a website to load on advertisements and incentive values (see at least Fig. 1 and associated text).

As to claim 24, Freeman discloses a point card with advertisement information recorded thereon, URL information unique to said advertisement information, and program information

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(see above claim 23) . Freeman does not specifically disclose questionnaire information, however , as explained above in claim 17 and 18, the questionnaire information is non-functional data thus patentability is not thereby determined.

Claim 25 is a combination of claims 23 and 24 and is rejected based on Freeman because both advertisement and questionnaire are non-functional data as explained above.

Conclusion

12. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

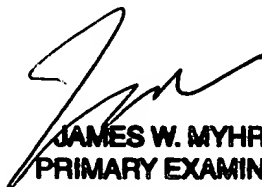
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

June 25, 2004

KHL


JAMES W. MYHRE
PRIMARY EXAMINER